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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,162	01/19/2001	Donald S. Gardner	42390P10775	9142

8791 7590 09/02/2003

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EXAMINER

NGUYEN, TUYEN T

ART UNIT	PAPER NUMBER
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2832

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/766,162

Applicant(s)

Gardner

Examiner

TUYEN T NGUYEN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-9, 11 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, applicant should clarify what is intended by “wherein the magnetic layer defines at least one slot *independent of a shape of the conductor*.”

Regarding claim 8, there is no antecedent basis for “the other magnetic layers.”

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5 and 7-8 rejected under 35 U.S.C. 102(b) as being anticipated by Mizoguchi et al. [US 5,583,474]

Mizoguchi et al. discloses an inductor [figures 5-6 and 38-39] comprising:

- a semiconductor substrate [10];
- a first dielectric layer [20A] over the substrate;

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- a first magnetic layer [30A] over the first dielectric layer;
- a second dielectric layer [20B] over the first magnetic layer;
- a conductor [40] over the second dielectric layer;
- a third dielectric layer [20C] over the conductor; and
- a second magnetic layer [30B] over the third dielectric layer and the conductor.

wherein at least one of the magnetic layers includes at least one slot/groove and formed of CoZrNb.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6, as best understood in view of the rejection under 35 U.S.C. 112 second paragraph, is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizoguchi et al. in view of Mandai et al. [US 4,543,553].

Mizoguchi et al. discloses the instant claimed invention except for at least one slot formed in the magnetic layer.

Mandai et al. discloses an inductor device comprising a plurality of magnetic layers [1-8] and a coil structure [9-21] extending between the magnetic layers, wherein at least one slot [22-27] formed in the magnetic layers.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include at least one slot in the magnetic layers of Mizoguchi et al., as suggested by Mandai et al., for the purpose of providing connections.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizoguchi et al. in view of Kobayashi et al. [US 4,791,719].

Mizoguchi et al. discloses the instant claimed invention except for the magnetic layers being connected to each other.

Kobayashi et al. discloses a magnetic device [figure 3] comprising upper and lower magnetic layers [7A, 3] and a coil conductor [5] disposed between the magnetic layers, where the magnetic layers are connected.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the magnetic layers of Mizoguchi et al., as suggested by Kobayashi et al., for the purpose of completing the magnetic circuit.

Response to Arguments

Applicant's arguments with respect to claims 5-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUYEN T NGUYEN whose telephone number is 703-308-0821. The examiner can normally be reached on M-F 8:30-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ELVIN ENAD can be reached on 703-308-7619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

TTN *TTN*

Truyen T. Nguyen